

## REMARKS

Claim 1 has been amended. Claims 20-25 were previously withdrawn. Claims 1-9 and 11-33 are pending and under consideration in the application.

Favorable reconsideration of this application, in light of the following discussion and in view of the present amendment, is respectfully requested.

This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding.

### Entry of Amendment under 37 C.F.R. § 1.116

The Applicants request entry of this Rule 116 Response because the amendment does not significantly alter the scope of the claims and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures (M.P.E.P.) sets forth in Section 714.12 that “any amendment that would place the case either in condition for allowance or in better form for appeal may be entered.” Moreover, Section 714.13 sets forth that “the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.” The M.P.E.P. further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

### **Rejection under 35 U.S.C. § 101**

The Examiner rejects claims 1-26 under 35 U.S.C. 101 as being directed to non-statutory subject matter. Claim 1 has been amended in response to this rejection. Accordingly, withdrawal of the § 101 rejection is respectfully requested.

### **Rejection under 35 U.S.C. § 103**

The Examiner rejects claims 1-3, 26-27, 29, and 31-33 under 35 U.S.C. 103(a), as being unpatentable over Atlas ATM website, hereinafter “Atlas”, in view of U.S. Patent 6,195,694 to Chen et al., hereinafter, “Chen 694” and in view of U.S. Patent App. Pub. No. 2002/0032656 of Chen et al., hereinafter, “Chen 656”.

This rejection is respectfully traversed.

Independent claim 1, for example, recites:

determining, when a credit card is used as payment by a customer for a transaction through the ATM related to web contents, whether or not a financial institution that issued the credit card used is identical to a service provider that installed the ATM;

obtaining, when it is determined that the financial institution that issued the credit card used is identical to the service provider that installed the ATM, electronic history information of the ATM, the electronic history information of the ATM consisting of beneficial browsing that provides benefits to the financial institution as the service provider on the Internet as a result of browsing of the web contents; and

determining the ATM placement fee, which is to be paid to the fee recipient entity, in a computer-implemented way based on said obtained electronic history information.

It is respectfully submitted that these features of claim 1 are not taught by Atlas, Chen 694, or Chen 656 and, therefore, claim 1 patentably distinguishes over the combination.

In rejecting claim 1, the Examiner indicates that Chen 694 discloses that “the operator of the kiosk receives payment from a service provider, such as a bank, when a user operates the kiosk to perform a web browsing function the benefits the service provider, and wherein the payment may be based on the time or duration that the information is provided by the kiosk.” This is submitted to be incorrect. Chen 694, in col. 6, merely discloses that “the amount of the fee might be based on: the location of the kiosk, the position/location of the selection function/information on the kiosk (e.g. graphical user interface), the size of the selection function 105A, the time and duration that the selection function 105A/information is provided by the kiosk, etc.” However, Chen 694 does not disclose that the amount of the fee is determined based on actual browsing using the selection function 105A/information is displayed on the screen of the kiosk. As such, Chen 694 does not disclose “obtaining ... electronic history information of the ATM, the electronic history information of the ATM consisting of beneficial browsing that provides benefits to the financial institution as the service provider on the Internet as a result of browsing of the web contents” and “determining the ATM placement fee, which is to be paid to the fee recipient entity, in a computer-implemented way based on said obtained electronic history information,” as recited in claim 1. Neither Atlas nor Chen 656 make up for this deficiency in Chen 694.

Furthermore, as mentioned above, claim 1 provides for obtaining electronic history of the ATM that consists of beneficial browsing that provides benefits to the financial institution as the service provider on the Internet as a result of browsing of the web contents. Chen 694, in col. 6, merely discloses that “the selection functions 105A, and/or other information displayed, also can be a source of revenue for the owner/operator of the kiosk. For example, notices provided by the

kiosk can be advertisements made for a fee. Application providers (e.g. banks, mutual funds, mortgage companies, lenders, brokers (stock, real estate), rental businesses (cars, equipment), services providers, and retailers) would pay a fee to have a selection function 105A on the kiosk 100/200 that the user would select to configure the kiosk to their application.” As such, the bank providing the application is different from the installer of the kiosk. Thus, in Chen694, displaying the selection function 105A/information is beneficial to the bank and not the installer of the kiosk.

Furthermore, in rejecting claim 1, the Examiner indicates that Chen 656 “teaches levying a surcharge to a user of an ATM if the card used to perform the transaction was not issued by the service provider that installed the ATM.” However, Chen 656 merely discloses that “a fee charged to the consumer for the convenience of using an ATM owned by any entity other than the consumer's financial institution.” Thus, Chen 656 does not disclose determining an ATM placement fee as recited in claim 1, for example. Neither Atlas nor Chen 694 make up for this deficiency in Chen 656.

Since the cited references, alone or in combination, do not discuss or suggest all of the features of claim 1, claim 1 patentably distinguishes over the cited references. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 2-9, 11-19, and 26 depend either directly or indirectly from claim 1, and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon (including U.S. Patent 6,672,505 to Steinmetz, which fails to make up for the deficiencies in the combination of the cited references noted above). Therefore, claims 2-9, 11-19, and 26 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

Independent claims 27, 29, and 31-33 include features similar to those discussed above with respect to claim 1. Therefore, claims 27, 29, and 31-33 patentably distinguish over the cited references for at least the reasons discussed above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

Claims 28 and 30 depend from claims 27 and 29, respectively, and include all the features of claims 27 and 29, respectively, plus additional features that are not discussed or suggested by the references relied upon (including U.S. Patent 6,672,505 to Steinmetz, which fails to make up for the deficiencies in the combination of the cited references noted above). Therefore, claims 28 and 30 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

**SUMMARY**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

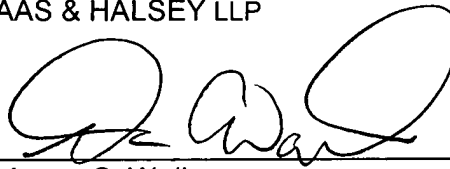
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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